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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/646,626	09/20/2000	Dieter Bauerfeind	10677/31	5098

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EXAMINER

BECKER, SHAWN M

ART UNIT	PAPER NUMBER
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2173

DATE MAILED: 01/14/2004

10

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/646,626

Applicant(s)

BAUERFEIND, DIETER

Examiner

Shawn M. Becker

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 24 October 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 10-23 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 10-23 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

This action is responsive to communication filed 10/24/03.

#### ***Claim Rejections - 35 USC § 112***

1. Claims 22-23 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
2. Claim 22 recites the limitation "the button" in line 7 of the claim. There is insufficient antecedent basis for this limitation in the claim.
3. Claim 22 recites the limitation "the active button" in line 12 of the claim. There is insufficient antecedent basis for this limitation in the claim.

#### ***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 10-21 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 5,877,957 to Bennett (hereinafter Bennett).
6. Referring to claims 10, 20, and 21, Bennett teaches a programmable controller (col. 3, line 33) comprising a processing unit/means (Fig. 2, CPU 26), a display screen/means including

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a menu-assisted user interface (Fig. 19 and col. 15, lines 18-22), an operator unit including a button, the button capable of being switched to an active mode using a programmable function (see col. 15, line 65 - col. 16, line 34 which describes activating one of the keypad buttons to be a trigger event for switching the mode of a device after selecting the "Training" button) at least one signal input terminal (i.e. link that receives trigger event; col. 2, line 39), at least one signal output terminal (i.e. link that broadcasted control signal; see col. 3, lines 47-57) and a housing unit in which the processing unit, the display screen, the operator unit, the at least one signal input terminal, and at least one signal output terminal are disposed. See col. 15, lines 18-65 and Fig. 19.

Bennett discloses a switching function of the controller programmable in a programmed sequence according to predetermined functions using the menu-assisted user interface, and wherein an operation of the button is capable of affecting a switching sequence of the switching function when the button is in the active mode. See col. 15, line 65 - col. 16, line 34, which describes how selection of the keypad button that is the trigger event switches at least one of the devices in the house.

Referring to claim 11, an operation of the button of Bennett can simulate at least one signal input when the button is in the active mode. See col. 8, lines 7-10. Also, see col. 15, line 65 - col. 16, line 34, which describe using a button on the programmable controller as the trigger event to turn on a lamp instead of the turning on of a different lamp as in Fig. 10, for example.

Referring to claims 12-13, the [programmed sequence of the] switching function of Bennett is interrupted when the button (trigger event) is operated in the active mode. See col. 2, lines 26-47.

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Referring to claim 14, the operation of the button of Bennett is performable at any point of the programmable switching function. See col. 16, lines 36-43, which shows a menu option for allowing the switch to occur at all times.

Referring to claim 15-16, Bennett shows a second button capable of affecting the switching function and capable of being switched to an active mode. See the plurality of buttons on the keypad in Fig. 19 and col. 15, line 65 - col. 16, line 34.

Referring to claim 17, the display screen of Bennett is capable of displaying an instruction to operate the active button. See Fig. 19, and example instructions at col. 16, lines 25-30.

Referring to claim 19, the switching function of Bennett is arranged to switch between input voltages applied to the at least one signal input terminal and the at least one signal output terminal. For example, see col. 5, lines 10-34 and 49-62, which describe an input trigger event, which may be a device turning on (requiring voltage), that causes a device (i.e. lamp) to turn on (output voltage).

Referring to claim 22, Bennett discloses a method for directing current by a programmable controller including a processing unit (Fig. 2, CPU 26), a display screen (Fig. 19), at least one signal input terminal (i.e. link that receives trigger event; col. 2, line 39), at least one signal output terminal (i.e. link that broadcasted control signal; see col. 3, lines 47-57), a common housing, the processing unit, the display screen, the signal input terminal, and the signal output terminal accommodated in a common housing (col. 15, lines 18-65 and Fig. 19), and an arrangement configured to program switching functions on the basis of a predetermined function

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in accordance with a menu-assisted user interface on the display screen, a sequence of a switching function dependant on operation of a button. See col. 15, line 65 - col. 16, line 34, which describes how selection of the keypad button that is the trigger event switches at least one of the devices in the house.

Bennett enters a program into the process into the processing unit including switching functions configured to control current flow between the at least one input terminal and the at least one output terminal (col. 2, lines 29-47 and col. 7, lines 54-58).

Bennett simulates a current in at least one of the at least one input terminals by using an active button. See col. 8, lines 7-10. Also, see col. 15, line 65 - col. 16, line 34, which describe using a button on the programmable controller as the trigger event to turn on a lamp instead of the turning on of a different lamp as in Fig. 10, for example. Therefore, pressing the button simulates the current from the "other" lamp in order to turn on the lamp.

Referring to claim 23, Bennett describes operating means including a button switchable to the active button in accordance with a programmable function and further including the step of switching the button to the active button. See the buttons on the keypad in Fig. 19 and col. 15, line 65 - col. 16, line 34, which describes switching the keypad buttons to active buttons.

### ***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bennett and U.S. Patent No. 5,997,167 to Crater et al. (hereinafter Crater).

The display screen of Bennett is capable of displaying an instruction to operate the active button. See Fig. 19, and example instructions at col. 16, lines 25-30. Bennett also shows a speaker in Fig. 19, but does not explicitly state that the instruction to operate the active button is accompanied by an acoustic signal. However, Crater discloses a programmable controller with diagnostic and simulation facilities that plays an audible alarm (acoustic signal) along with directions on the display. See col. 6, lines 39-44. It would have been obvious to one of ordinary skill in the art to use the speaker of Bennett to play an acoustic signal that accompanies the display of an instruction to operate the active button in order to capture the operator's attention as supported in Crater.

#### ***Response to Arguments***

9. Applicant's arguments filed 10/24/03 have been fully considered but they are not persuasive.

10. Applicant argues the newly presented limitations of a signal input terminal and a signal output terminal patentably distinguishes claims 10, 20, and 21 over the prior art. However, Microsoft Computer Dictionary, Third Edition, ©1997, defines a terminal as, "In electronics, a point that can be physically linked to something else, usually by a wire, to form an electrical connection." Therefore, in order for programmable controller of Bennett to receive input and send output through the communication link, the link must be connected at a point on the programmable controller, so there must be a point for receiving input (an input terminal) and a

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point for sending output (output terminal). Furthermore, Bennett describes that the connections may be over dedicated wiring, which inherently is linked to terminals. See col. 6, lines 22-27.

With regard to claims 11-19, Applicant alleges that Bennett does not disclose the limitations in each claim, but provides no substantial supporting arguments to back these allegations. Claims 11-19 are rejected under Bennett by the reasoning set forth above.

11. In response to applicant's argument with respect to claim 18 that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

In the instant case, both Bennett and Crater are directed to programmable controllers. Crater discloses accompanying a direction with an audible alarm, and operating the active button in Bennett is a direction, therefore the combination of Bennett and Crater results in playing an audible alarm when the active button is operated. One of ordinary skill in the art would have been so motivated to make this combination in order to capture the operator's attention as supported in Crater when the active button is operated.

### ***Conclusion***

12. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).



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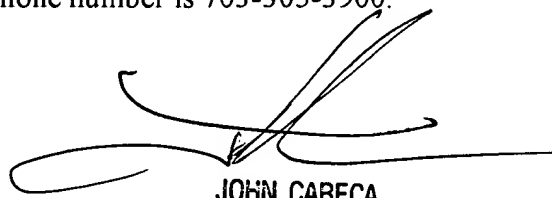
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shawn M. Becker whose telephone number is 703-305-7756. The examiner can normally be reached on M-Th 8:00 - 5:30 and alternating Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John W. Cabeca can be reached on 703-305-3116. The fax phone number for the organization where this application or proceeding is assigned is 703-746-7239.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

smb



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